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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,032	03/20/2002	Hai(NMN) Ye	AA484F	5117

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THE PROCTER & GAMBLE COMPANY
PATENT DIVISION
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EXAMINER

ROSE, SHEP K

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019032

Applicant(s)

YVB et al

Examiner

STEP ROSE

Group Art Unit

1614

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1028 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1028 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 7
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

The application is assigned to Procter & Gamble.

The common assignee has four (4) copending applications, namely Serial Nos. 10/019,029, 10/019,031, 10/019,038, and 10/019032 whose claims overlap in scope, presenting an issue of obviousness-type double patenting (one which can be overcome by filing acceptable terminal dis-claimers). Each claims oralcare actives in an (A) organosiloxane resin and/or admixture with fluid (B) diorganopoly siloxane –based polymers (C) volatile solvents, etc, and the actives (D) can be:

(bleach) whitening actives, or pigments, opacifiers or colorants, etc.

The common assignee has six (6) issued U.S. patents, identified herein as Drechsler et al (I to VI), whose composition claims raise an issue of obviousness-type double patenting of the composition claims presented herein (one which can be overcome by filing acceptable terminal disclaimers), the patented commonly assigned Drechsler et al patents composition claims encompass the same (A), (B), and (C) with (D) pigment, opacifiers, or colorants, (even if not intended for oralcare). No weight is given in the USPTO for statements of intended use in composition claims.

The Hughes (I-V) patents teach whitening actives for dentures 1 and/or teeth in oralcare silicones, and Suchan et al teaches a tooth paint for coloring or tinting pigments onto teeth.

In Serial No. 10/019,029, there are 17 claims with composition claims 1 to 15 to (A),(B),(C),(D), (as noted above). The (D) actives, composition claims 4, 5, 14, 15 can be pigment/whitener pigment in claims 4, 14, whiteners in claims 5 and 15.

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In Serial No. 10/019,031, there are 30 claims, with composition claims 1 to 28 to (A) (B) (C) (D), (as noted above), the (D) actives can be pigments coloring agents opacifiers claims 9, 23, or whiteners, claims 9, 11, 23, 25.

In Serial No. 10/019,032, there are 28 claims, with composition claims 1 to 24 to (A), (B), (C), (D), (as noted above). The (D) actives can be pigments, coloring agents, opacifiers, claims 4, 15 or whiteners, claims 4, 6, 15, 17.

In Serial No. 10/019,038, there are 26 claims, with composition claims 1 to 24 to (A), (B), (C), (D) (as noted above). The (D) actives can be pigments, coloring agents, opacifiers, claims 7, 8, 13 (etc), or whiteners, claims 10, 22.

Drechsler et al (I), I.S. 6,406,683, contains composition claims 1 to 4 to (A), (B), (C), (D) pigments.

Drechsler et al (II), I.S. 6,340,466, contains composition claims 1 to 20 to (A), (B), (C), (D) pigments (claim 3).

Drechsler et al (III), U.S. 6,139,823, contains composition claims 1 to 18 to (A), (B), (C), (D), pigments (claim 11).

Drechsler et al (IV), U.S. 6,071,503, contains composition claims 1 to 4 to (A) (B) (C) (D) (pigments).

Drechsler et al (V), U.S. 6,019,962, contains only method claims 1 to 12 wherein (A), (B), (C) is "applied," (not necessarily a lip cosmetic product applied to the lips, claim 2).

Suchan et al U.S. 4,032,627 describes a tooth paint whitening cosmetic wherein pigments, opacifiers, solvents, etc. are applied to teeth like nail polish, or correction fluid "white out".

Hughes (I) to (V) teeth encompassed species of tooth bleach whitening actives in silicone carriers, to remove stains from dentures and/or teeth.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 to 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 30 of copending Application No. 10/019,031. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 to 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 26 of

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copending Application No. 10/019,038. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 to 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 4 of U.S. Patent No. 6,406,683 in view of Suchan and Hughes (I-V) teaching the application to teeth or dentures of pigments, etc and bleaching actives (as noted above). It would be obvious therefrom to formulate oralcare (A), (B), (C), (D) with pigments and whiteners for teeth.

Claims 1 to 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 20 of U.S. Patent No. 6,340,466 in view of Suchan and Hughes (I-V) (same teachings, as noted above). Same reasons (as noted above).

Claims 1 to 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 18 of U.S. Patent No. 6,139,823 in view of Suchan and Hughes (I-V) (same teachings, as noted above). Same reasons (as noted above).

Claims 1 to 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 4 of U.S. Patent No. 6,071,503 in view of Suchan and Hughes (I-V) (same teachings, as noted above). Same reasons (as noted above).

From the teaching of the references, it was apparent that one of ordinary skill in the art would have had reasonable expectation of success in producing the claimed invention. Therefore the invention as a whole was prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shep Rose whose telephone number is (703) 308-4609. The examiner can normally be reached on Monday, Tuesday and Thursday from 7:30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Shep Rose

**SHEP K. ROSE
PRIMARY EXAMINER**

Rose/LR
October 28, 2002